



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,595	04/28/2000	Madeleine Prigent	Q58982	3132

7590

08/27/2003

Sughrue Mion Zinn Macpeak & Seas PLLC
2100 Pennsylvania Avenue
Suite 800
Washington, DC 20037-3213

EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
----------	--------------

1774

90

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,595

Applicant(s)

PRIGENT ET AL.

Examiner

Jill M. Gray

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1774

I. 1. Response to Amendment

2. The rejection of claims 1, 3-7 and 9-16 as being unpatentable over Dickinson 5,173,960 in view of Smith et al, 6,190,775 B1 (Smith) is withdrawn in view of Applicants arguments and submission of certified translation of the priority document.

II. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

III. Claims 1, 3-7 and 9-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for at least one covering layer comprising a composite material, wherein the covering layer is formed from inorganic particles dispersed within a polymer material, does not reasonably provide enablement for a covering layer comprising a composite material wherein the composite material is in the form of particles. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In particular, a covering layer comprising a composite material in the form of particles embraces particulate coating materials-such as powder coatings, which is not supported by the specification. Note pages 3, 4 and 6 of the specification, in particular page 6, wherein the treated inorganic compound is blended with a polymer, and then extruded or molded around the cable. Claims 3-7 and 9-14 do not rectify, claim 1 and thus are not commensurate in scope with the enabling disclosure.

IV. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1774

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

V. Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

VI. Claims 12-14 recite the limitation "said covering material" in line 3 of each claim. There is insufficient antecedent basis for this limitation in the claim.

In particular, the scope of these claims is indeterminate because it is not clear as to whether the "covering layer" or "composite material" is being referenced.

VII. Claim 15 is indefinite because this claim does not describe a method for making a cable. There are no method steps specific to cable formation. Also, this claim requires that "said inorganic compound particles are treated with an agent so as to ensure that said inorganic compound particles are compatible with said organic compound". The terms "treated" and "compatible" render this claim indefinite because the treating method is not clearly defined and it is not clear as to what is meant by "compatible". This term implies easily dispersible, as good adhesion, or synergy. Accordingly, the metes and bounds for which patent protection is being sought is not clearly defined.

Claim 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 703-308-2381.

Application/Control Number: 09/559,595
Art Unit: 1774

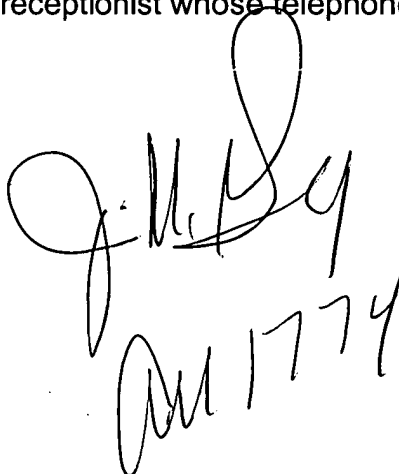
Page 4

The examiner can normally be reached on M-F from 9:30 am – 7:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

J. Gray/mn
August 18, 2003

Handwritten signature of J. Gray and the text 'Am 1774'.